

REMARKS

The foregoing amendments to the claims have been made to more particularly point out and distinctly claim the subject matter which applicant respectively regards as the claimed invention and to broaden each of the claims respective scopes rather than to avoid the prior art.

Applicants respectfully requests reconsideration of this application as amended. Claims 1-23 are pending in the application. Claims 1-23 are rejected. Claims 1 and 4 are amended.

Rejections under 35 USC § 102 (e)

The Office Action mailed May 23, 2006 rejects Claims 1-3, 7-10, 15-16 and 18-22 under 35 USC § 102 (e) as allegedly being anticipated by US Pat No 6,167,289 (Ball).

The Examiner indicates that the subject matter of Claims 1, 7, 9, 15 and 18 is anticipated by the material in Fig. 1 and col. 4, lines 25-35; col. 8, lines 35-45; col. 9, lines 30-45 and the abstract of Ball.

Ball discloses in col. 4, lines 25-35 that:

A first MOSFET switch M1 controls connection of the external battery I/O line 46 to the phone power output 40, and second MOSFET switch M2 controls connection of the internal battery I/O line 44 to the phone power output 40. The condition of the switches M1 and M2 is controlled by first and second signal outputs OUT1 and OUT2 from the control logic module, as explained in more detail in Tables 1, 2, and 3 below.

Ball discloses in col. 8, lines 35-45 that:

The microcontroller software reads each battery voltage via the analog to digital converter 52, and continuously monitors the overall capacity of both battery packs, displaying the result on the phone monitor. If both the internal and external batteries are at or below 3.4 volts, the software will indicate a low battery condition to the user and will turn off the phone.

Ball discloses in col. 9, lines 30-45 that:

The control circuit and software illustrated in FIGS. 1 and 2 and Tables 1 to 3 above automatically controls power supply to the phone circuitry and also controls charging of both the internal and external batteries. The software is designed to always provide power from the external battery when present, if it has a sufficiently high voltage and if no external power is present on line 40. If the external battery is detected to be removed or at too low a voltage, the software is arranged to automatically switch to the internal battery. This enables users to swap one external battery pack for a new battery pack, even when the phone is switched on or during a call, without loss of signal. The software is also designed to always charge the internal battery first, and to trickle charge when necessary, followed by fast charge when the battery voltage is high enough. This reduces charging time.

Ball discloses in the abstract that that:

A portable phone has an internal battery and an external battery pack is releasably attachable to the phone. A control unit in the phone controls connection of the respective batteries to a phone power input, depending on the detection of the external battery voltage. Whenever an external battery is present with a voltage above a predetermined minimum value, the external battery will be connected to the phone power input to provide power to operate the phone, so that the internal battery lifetime is extended. When the external battery voltage falls below the minimum value, or the external battery is removed, the unit automatically switches to internal battery power, so that the external battery can be changed without interrupting power supply to the phone, if the phone is on or during a call.

Applicant respectfully submits that Ball is directed to a control unit in a phone that controls connection of the respective batteries to the phone power input. When the external battery voltage falls below the minimum value, or the external battery is removed, the unit automatically switches to internal battery power, so that the external battery can be changed without interrupting power supply to the phone. This enables users to swap one external battery pack for a new battery pack, even when the phone is switched on or during a call, without loss of signal.

On the other hand, Claim 1, as amended, sets forth:

1. (Currently Amended) A system comprising:
 - at least one electronic component;
 - a back-up battery to provide a back-up voltage supply on a back-up supply node;
 - a battery check circuit to be powered by the back-up

voltage supply and to determine, in response to an attempt at system power-on, whether to provide power from a battery different than said back-up battery to the at least one electronic component by comparing the battery's power level to a predetermined power level.

Ball does not disclose or suggest a battery check circuit powered by a back-up voltage supply to determine, in response to an attempt at system power-on, whether to provide power from a battery different than said back-up battery. Ball discloses instead automatically switching between the two batteries and external DC power when the phone is switched on or during a call.

Claim 7, for example, also sets forth:

7. (Original) A method comprising:
 - powering, using a second battery, a battery check circuit for testing a power level of a first battery upon system startup regardless of a power state of the first battery;
 - testing whether the power level of the first battery is less than a first level responsive to a stimulus that indicates application of power is desired but before power is provided;
 - preventing the first battery from powering an electronic component if the power level is less than the first level; and
 - enabling circuitry to provide power from the first battery to the electronic component if the power level is at least the first level.

Ball does not disclose or suggest powering, using a second battery, a battery check circuit for testing a power level of a first battery upon system startup or in response to a stimulus that indicates application of power is desired but before power is provided. Again, Applicant respectfully submits that Ball discloses instead automatically switching between the batteries when the phone is switched on or during a call.

Claim 15 further sets forth:

15. (Original) A method comprising:
 - receiving an enabling signal;
 - latching power from a first battery responsive to the enabling signal;
 - powering a test circuit from the first battery via the latch circuit;
 - testing a charge level of a second battery via the test circuit;

and

asserting a shutdown signal if the charge level is less than a predetermined charge level.

Ball does not disclose or suggest latching power from a first battery (as set forth for example, in Claim 15 and also in Claim 8) responsive to the enabling signal and powering a test circuit via the latch circuit to test a charge level of a second battery.

In fact the Examiner admits with regard to Claim 12 and Claim 23 that Ball does not disclose maintaining power to a battery check circuit by setting a latch and finds it necessary to take Official Notice that a latch is known in the art (p. 6, par. 3).

Claim 18 further sets forth:

18. (Original) An apparatus comprising:

- a main battery, the main battery having a charge status;
- a backup battery;
- a plurality of system components;
- a power switch; and
- a battery check circuit that is, in response to actuation of the power switch, powered during a battery test interval exclusively by the backup battery, regardless of the charge status of the main battery, the battery check circuit to determine based on the charge status of the main battery whether to supply power from the main battery to the plurality of system components.

Ball does not disclose or suggest a power switch and a battery check circuit that, in response to actuation of the power switch (as set forth for example, in Claim 18 and also in Claim 11) is powered during a battery test interval exclusively by the backup battery, regardless of the charge status of the main battery, the battery check circuit to determine whether to supply power from the main battery to the system components based on the charge status of the main battery.

In fact the Examiner admits with regard to Claim 11 that Ball does not disclose sensing a power/on button being depressed and powering a battery test/check circuit. Moreover, the Examiner once again, finds it necessary to take Official Notice that an on-button is known in the art (p. 6, par. 3).

Applicant also respectfully notes that Ball does not disclose or suggest a battery check circuit that enables a voltage regulator (for example, as set forth in Claim 20).

Applicant respectfully submits that, especially with regard to Claims 7, 8, 15, 18 and 20, where the actual language of the Claims was not even compared with the cited reference, the Examiner has failed to make a *prima facie* case of anticipation.

Appellant respectfully submits that in order for a rejection based on anticipation to be made, the identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Accordingly, Applicant respectfully requests withdrawal of the Rejections of Claims 1-3, 7-10, 15-16 and 18-22 under 35 USC § 102 (e).

Rejections under 35 USC § 103 (a)

The Office Action rejects Claims 11-14, 17, 22 and 23 under 35 USC § 103 (a) as allegedly being unpatentable over US Pat No 6,167,289 (Ball).

The Examiner indicates with regard to the subject matter of Claims 11 that it would have been obvious to one skilled in the art to include an on-button... wherein powering the battery check circuit comprises sensing an on button being depressed, enabling power to the battery check circuit, maintaining power to the battery check circuit while the power of the first battery level is tested for the purpose of initiating and testing of the battery as and when required.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant respectfully submits that there is no suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to obtain the subject matter set forth in Claim 11.

If the Examiner is taking Official Notice of such a suggestion or motivation in common knowledge generally available in the art, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.

Applicant also respectfully submits that the prior art reference does not teach or suggest all the claim limitations. As Applicant has presented above with regard to Claim 7, Ball does not disclose or suggest powering, using a second battery, a battery check circuit for testing a power level of a first battery upon system startup. The Examiner has also admitted that Ball does not disclose wherein powering the battery check circuit comprises: sensing an on button being depressed; enabling power to the battery check circuit; maintaining power to the battery check circuit while the power level of the first battery is tested.

Thus a combination of an on button with the disclosed control unit in a phone that automatically switches to internal battery power, so that the external battery can be changed without interrupting power supply to the phone does not teach or suggest all the claim limitations.

Accordingly, Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness.

The Examiner indicates, with regard to the subject matter of Claims 12 and 23, that Official Notice is taken that a latch and a gate are well-known in the art. In the instant case of Claim 12 and 23, no attempt is made, even to argue that there is a suggestion or motivation, either in the reference or in the knowledge generally available

to one of ordinary skill in the art, to modify the reference to obtain the subject matter set forth in the Claims.

If the Examiner is taking Official Notice of such a suggestion or motivation in common knowledge generally available in the art, the Examiner must provide specific factual findings to support his or her conclusion of common knowledge.

Applicant also respectfully submits that the prior art reference does not teach or suggest all the claim limitations. Applicant has presented arguments above with regard to Claims 7 and 11. Applicant has also presented arguments above with regard to Claims 11 and 18, that Ball does not disclose or suggest a power switch and a battery check circuit that, in response to actuation of the power switch is powered during a battery test interval exclusively by the backup battery, regardless of the charge status of the main battery, the battery check circuit to determine whether to supply power from the main battery to the system components based on the charge status of the main battery.

The Examiner has also admitted that Ball does not disclose wherein maintaining power to the battery check circuit comprises setting a latch which has its output coupled to enable a gate connecting the battery check circuit to the second battery.

Thus a combination of an on button, a latch and a gate with the disclosed control unit in a phone that automatically switches to internal battery power, so that the external battery can be changed without interrupting power supply to the phone does not teach or suggest all the claim limitations.

Accordingly, Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness.

Applicant also respectfully submits that with regard to the rejection of Claims 13 and 14, again no attempt is made, even to argue that there is a suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to obtain the subject matter set forth in the Claims.

If the Examiner is taking Official Notice of such a suggestion or motivation in common knowledge generally available in the art, the Examiner must provide specific factual findings to support his or her conclusion of common knowledge.

Applicant respectfully submits that with regard to the rejection of Claim 22, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2142).

Accordingly, Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness.

Accordingly, Applicant respectfully requests withdrawal of the Rejections under 35 USC § 103 (a).

Rejections under 35 USC § 112

The Office Action rejects Claims 1-6 under 35 USC § 112, first paragraph, for allegedly failing to comply with the enablement requirement.

With regard to Claim 1, the Examiner states that, the claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and or use the invention, citing the language, "in response to an attempt to provide power to the at least one electronic component." Applicant respectfully disagrees.

Appellant submits that the instant language "to determine, in response to an attempt to apply power to the at least one electronic component, whether to provide power from a battery," is both clear on its face and well supported by the specification, but that language is no longer at issue. In order to further progress in the present application, Applicant has amended Claim 1 to recite, "to determine, in response to an attempt at system power-on, whether to provide power from a battery different than said

back-up batter.” Applicant hereby respectfully submits the amended claim for reconsideration.

The Office Action also rejects Claims 1-6 under 35 USC § 112, second paragraph, for allegedly being indefinite.

With regard to Claim 1, the Examiner takes issue with, “whether to provide power from a battery,” and with “comparing the battery power level to a predetermined power level.” The instant language has been amended to recite, respectively, “whether to provide power from a battery different than said back-up battery,” and “comparing the battery’s power level to a predetermined power level.”

The Examiner also indicates that the term “back-up battery” makes the metes and bounds of the claimed invention indefinite. Applicant respectfully disagrees.

Claims are construed through whose eyes of a person of ordinary skill in the art who has read and understood the specification and relevant prior art.

It was explained recently in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313; 75 U.S.P.Q.2D (BNA) 1321 (Fed. Cir. 2005): “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. This court explained that point well in *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998):

It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field. The inventor’s words that are used to describe the invention--the inventor’s lexicography--must be understood and interpreted by the court as they would be understood and interpreted by a person in that field [**25] of technology. Thus the court starts the decision making process by reviewing the same resources as would that person, viz., the patent specification and the prosecution history.

See also *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) (“We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we

must look at the ordinary meaning in the context of the written description and the prosecution history."); *V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1310 (Fed. Cir. 2005) (intrinsic record "usually provides the technological and temporal context to enable the court to ascertain the meaning of the claim to one of ordinary skill in the art at the time of the invention"); *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 375 F.3d 1341, 1351."

See also *Research Plastics, Inc. v. Fed. Packaging Corp.*, 421 F.3d 1290, 1295 (Fed. Cir. 2005) ("Claim construction begins with the language of the claims. *Vitronics Corp. v. Conceptiontronic Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). The words of a claim are generally to be accorded their "ordinary and customary meaning," *id.* at 1582, which is "the meaning that term would have to a person of ordinary skill in the art in question at the time of invention,") also citing *Phillips*, 2005 U.S. App. LEXIS 13954, at *22 ("It is presumed that the person of ordinary skill in the art read the claim in the context of the entire patent, including the specification, not confining his understanding to the claim at issue.").

Applicant respectfully submits that to a person of ordinary skill in the art of designing portable computing devices, in the context of the entire patent, including the specification, not confining his understanding to the claim at issue, the term "back-up battery" does not render the claim indefinite. Therefore, Applicant respectfully submits the claim, as amended, for reconsideration.

With regard to Claim 4, the Examiner takes issue with the language, "provide power exclusively from the back-up supply node when the system is turned on, regardless of the battery power level of the battery." Applicant does not believe that the language was indefinite, but in order to further progress in the present application has amended the instant language to set forth, "provide power exclusively from the back-up supply node when the system is turned on." Therefore, Applicant respectfully submits the claim, as amended, for reconsideration.

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Accordingly, Applicant believes that Claims 1-23 are presently in condition for allowance and such action is earnestly solicited.

CONCLUSION

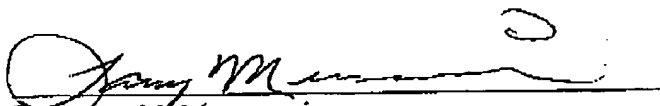
Applicant respectfully submits the present claims for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Lawrence Mennemeier at (408) 765-2194.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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